UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,912	11/23/1999	GUNNER D. DANNEELS	042390.P7609	4438

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EXAMINER
REAGAN, JAMES A

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

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<table>
<tr><td rowspan="3">**Office Action Summary**</td><td>Application No.
09/447,912</td><td>Applicant(s)
DANNEELS ET AL.</td></tr>
<tr><td>Examiner
James A. Reagan</td><td>Art Unit
3621</td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>23 September 2002</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>27-48</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>27-48</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

     If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____ .

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

     a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5)☐ Notice of Informal Patent Application (PTO-152)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .   6)☐ Other: .

DETAILED ACTION

Status of Claims

1.   This action is in response to the amendment received on 23 September 2002.

2.   Claims 27, 31, and 40 have been amended (paper #8).

3.   Claims 31-48 have been examined.

4.   The rejections of claims 27, 31, and 40 have been updated to reflect the amended limitations

5.   The rejections of claims 28-30, 32-39, and 41-48 are unchanged.

Response to Arguments

6.   Applicant's arguments with respect to claims 1, 2-4 and 6-11 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8.   Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included by the claim language. This claim is an omnibus type claim. Specifically, claim 27 cites the negative limitation of not using a cookie. Applicant, in an attempt to overcome the prior art of record, does not specifically disclose the nature of the communications between the club

member and the club affiliate. This leaves the claim wide open to subjective interpretation, making it vague and indefinite.

9.   The following is a **Final Rejection** of all claims and associated limitations pending in the current application as amended in paper #7.

Examiner's note: Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the *entire* reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 27:

With regard to the limitation of:

- *a club manager web site to create a club, the club manager web site including a registration component to register users as club members,*

Laor shows a registration function to register a user as a club member (column 2, lines 14-21, lines 26-30, and column 4, lines 5-14),

- *credential creation component to create a value token associating a selected club member with entitlement to a benefit and to cryptographically sign the value token to create a credential,* Laor discloses a coupon and coupon redemption for a benefit (column 2, lines 14-21).

- *the at least one affiliate web site including a credential verification component to verify the authenticity of the value token of the credential,* Laor discloses verifying the coupon and enabling the transaction (column 2, lines 14-21 and lines 53-60),

- *a benefit provision component to provide the benefit to the selected club member on demand if the value token is valid,* Laor discloses authenticating the coupon and authorizing the completion of the transaction (column 2, lines 39-45),

- *at least one club member coupled to the club manager web site to register for the club and to request the benefit, and coupled to the at least one affiliate web site to receive the benefit,* Laor shows a client coupled through the Internet to multiple servers for entry into a club and redemption of coupons from an affiliate (Figure 1 and associated text).

Laor does not disclose *at least one affiliate web site coupled to the club manager web site to receive the credential directly from the club manager web*

site. However, Gabber shows a method of communicating a credential to an affiliate without requiring the anonymous club member to store a value token (column 11, lines 15-54). In Laor, the credential is communicated to the affiliate in the form of a cookie stored on the user's computer. The value token contains information entitling the user to "a coupon" (Laor, column 2, line 1-21) that modifies a transaction. In Gabber the value token takes the form of data identifiers that allow server sites to recognize returning users and provide personalized service to them (Gabber, column 11, lines 56-58). These identifiers are transmitted directly from the proxy site to the server site (Gabber, column 7, lines 7-11). Both the coupon and data identifier applications of the value token fall under the applicant's definition of a value token as defined in the instant application (page 7, line 22). It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the method of using a cookie to transmit the value token to the affiliate with the method of direct transmission of the value token from the club manager (proxy site) to the affiliate because cookies may compromise a users security by collecting information about the user and transmitting that information back to a web-site without the user's knowledge (Gabber, column 2, lines 39-50).

With regard to the limitation of *without further interaction between the at least one club member and the club manager*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Laor and Gabber to prevent further communication between club members and

club managers. Naturally, if the transaction between the two parties were complete, then there would obviously be no need for further dialog or contact.

With regard to the limitation of *without using a cookie stored by the at least one club member*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Laor and Gabber to prevent the use of a cookie. A person of ordinary skill in the art would recognize that simply omitting the practice of using a cookie does not necessarily make the system unique, since there are many equivalent methods that may be substituted in place of a cookie.

Claim 28:

The combination of Laor/Gabber discloses the limitations as shown in the rejection of claim 27 above. Laor/Gabber do not specifically disclose that *the club member is anonymous from the perspective of the club manager and the at least one affiliate.* Gabber, however, in Figures 1-6 and related text, discloses a method of registering a user as an anonymous club member (Figure 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Laor/Gabber to include the method of anonymous registration of Gabber because anonymity prevents multiple sites from colluding to combine customer information using user names and passwords and build dossiers on particular customers (Gabber, column 2, lines 13-19). Additionally, it is important to note in the invention of Laor it is not explicitly stated that personal data is collected from the user during the registration process. Rather it is understood that during the

process of communicating the credential to the affiliate via the cookie placed on the client computer that the anonymity of the user is compromised. Thus, in the invention of Laor, once the cookie placed on the user computer is replaced with a method that allows the credential to be directly transmitted to the affiliate the user's anonymity is maintained.

Claim 29:

With regard to the limitation of *the club member comprises a user's personal computer and web browser,* Laor, in Figure 1 shows a client connected to the Internet, inherently disclosing a web browser. In addition, it would have been obvious to one of ordinary skill in the art at the time of the invention to assume that a club member would use their own personal computer from either the office or at home to access the club and the club's affiliates because using a personal computer is an effortless and efficient means to connect to Internet sites.

Claims 30, 36, and 45:

The combination of Laor/Gabber discloses the limitations as shown in the rejection of claims 27 above, and claims 31 and 40 below. Laor/Gabber do not specifically disclose that *the value token comprises a randomly selected transaction identifier associating the club member with the benefit, but not identifying any characteristics of the club member.* Gabber, however, does disclose a method that "...generates secure substitute identifiers (e.g., alias user names, passwords, e-mail addresses, postal addresses, credit card numbers,

etc.) that are distinct and secure for the user...the user provides one or more character strings (which may be random) (column 6, line 65 to column 7, line 2)." It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Laor/Gabber to include the method of producing an anonymous random number to identify a member with a benefit because using an anonymous string to recognize a transaction and a member maintains the secrecy of the user which prevents sites from collecting customer information using user names and passwords and building dossiers on particular customers (Gabber, column 2, lines 13-19).

Claims 31 and 40:

With regard to the limitations of:

- *registering a user as a member of a club by a club manager web site;*

- *generating a value token associating the club member with entitlement to the benefit due to membership in the club;*

- *cryptographically signing the value token;*

- *verifying, by the affiliated web site, that the signed value token is valid;* and

- *providing the benefit to the club member by the affiliated web site when the signed value token is valid,* see the rejection of claim 27 above.

Laor discloses *offering the benefit to the club member in a link to an affiliated web site* as shown above in the rejection of claim 27. Laor does not specifically disclose *authenticating the club member.* Gabber, however, in column 7, lines 21-24, discloses a "basic authentication request," which is a common procedure used by servers to identify users on the World Wide Web. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Laor with Gabber and utilize the old and well-known technique of authenticating registered users because authentications prevent fraud and abuse.

In addition, the combination of Laor/Gabber does not specifically disclose communicating the signed value token from the club manager web site directly to the affiliated web site without storing the signed value token by the club member. However, Gabber shows a method of communicating a credential to an affiliate without requiring the anonymous club member to store a value token (column 11, lines 15-54). In Laor, the credential is communicated to the affiliate in the form of a cookie stored on the user's computer. The value token contains information entitling the user to "a coupon" (Laor, column 2, line 1- 21) that modifies a transaction. In Gabber the value token takes the form of data identifiers that allow server sites to recognize returning users and provide personalized service to them (Gabber, column 11, lines 56-58). These identifiers are transmitted directly from the proxy site to the server site (Gabber, column 7, lines 7-11). Both the coupon and data identifier applications of the value token fall under the

applicant's definition of a value token as defined in the instant application (page 7, line 22). It would have been obvious to one of ordinary skill in the art at the time of the invention, to substitute the method of using a cookie to transmit the value token to the affiliate with the method of direct transmission of the value token from the club manager (proxy site) to the affiliate because cookies may compromise a users security by collecting information about the user and transmitting that information back to a web-site without the user's knowledge (Gabber, column 2, lines 39-50).

With regard to the limitation of *without further interaction between the at least one club member and the club manager*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Laor and Gabber to prevent further communication between club members and club managers. Naturally, if the transaction between the two parties were complete, then there would obviously be no need for further dialog or contact.

Claims 33 and 42:

Laor discloses multiple servers and a client connected through the Internet (Figure 1). Laor does not specifically disclose that *the club manager web site and the affiliated web site are operated by different entities.* Gabber, however, in Figure 2 shows multiple affiliates not associated with each other or a club manager. It would have been obvious to one having ordinary skill in the art at the time of the invention to combine Laor with Gabber because permitting non-affiliated groups to participate in a benefit-passing program between the websites

of multiple services and affiliations attracts more clients to the system, thereby increasing profitability.

Claim 37:

Laor discloses data representative of an electronic coupon serial number or identification number, data representative of a unique key that can be used to validate or authenticate the coupon, data representative of the vendor that authorized the coupon and will redeem the coupon, data representative of the nature of the discount or access provided by the coupon, data representative of the server or entity that issued the coupon (column 4, lines 7-14). Laor does not specifically disclose that *the value token is unique for a combination of the club member, the affiliated web site, and the benefit.* However, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the token to be exclusive to the club member, web site, and benefit transaction. By assigning only one unique key or identifier to each transaction, the details of each business deal may be stored for future identification and historical record.

Claims 38 and 47:

The combination of Laor/Gabber discloses the limitations as shown in the rejections of claims 31 and 40 above. Laor/Gabber do not specifically disclose *communicating the signed value token from the club manager web site to the affiliated web site comprises passing the signed value token as part of a form post to the affiliated web site.* Gabber, however, in column 11, line 7, discloses the use of electronic form processing. It would have been obvious to one of

ordinary skill in the art at the time of the invention to modify Laor/Gabber to include the use of electronic forms processing between web sites because electronic forms provide efficient and standardized procedures for posting, processing and transferring data between computers.

Claims 39 and 48:

Laor discloses using web browsers (column 3, lines 60-62). Laor does not disclose *communicating the signed value token from the club manager web site to the affiliated web site comprises passing the signed value token in a dynamic hyper text markup language (DHTML) link by using a web browser of the club member.* Gabber, however, in column 8, lines 12-16, does disclose the use of HTML documents. Although Laor/Gabber do not specifically disclose DHTML, it would have been obvious to combine Laor and Gabber and modify it to include dynamic HTML web functions because DHTML is a common web-based programming language.

11.   Claims 32, 35, 41, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laor/Gabber further in view of Barnett et al. (U.S. 6,321,208).

Claims 32 and 41:

The combination of Laor/Gabber discloses the limitations as shown in the rejections of claims 31 and 40 above. Laor/Gabber do not disclose *registering the signed value token as used by the affiliated web site, thereby preventing the club member from subsequently obtaining the benefit.* Barnett, however, in

column 5, lines 46-62 discloses registering the value token as used after the benefit transaction is completed. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Laor/Gabber with Barnett's registering the value token as used after the benefit transaction is completed. In certain instances an affiliate may want to offer a club member only one chance to redeem a value token in order that the club manager may reduce costs incurred by offering the benefit, thus it would be to the affiliate's advantage to register each token as used after the benefit transaction is completed.

Claims 35 and 44:

The combination of Laor/Gabber discloses the limitations as shown in the rejections of claims 31 and 40 above. Laor/Gabber do not disclose *verifying, by the affiliated web site, that the value token has not been previously used by any club member.* Barnett, in column 5, lines 46-62, discloses verifying the authenticity comprises determining that the value token has not been previously used. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Laor/Gabber with Barnett's verification of authenticity because by determining a value token has not previously been used a club manager or affiliate can reduce fraud and offer one-time use value tokens.

12.   Claims 34 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Laor/Gabber, further in view of Eggleston et al. (U.S. 6,061,660).

Claims 34 and 43:

The combination of Laor/Gabber discloses the limitations as shown in the

rejections of claims 31 and 40 above. Laor/Gabber do not disclose *billing the*

club member web site, by the affiliated web site, for the benefit delivered to the

club member. Eggleston, however, in column 15, lines 8-12 shows billing a club

manager for a benefit provided to a club member.   It would have been obvious

to one having ordinary skill in the art at the time of the invention to modify

Laor/Gabber with Eggleston's billing technique because billing a club manager

for a benefit provided allows a club manager to offer an incentive to a club

member without financially burdening the affiliate offering the benefit redemption.

Conclusion

13.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action.   Accordingly, **THIS ACTION IS MADE FINAL**.   See MPEP

§ 706.07(a).   Applicant is reminded of the extension of time policy as set forth in

37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire

THREE MONTHS from the mailing date of this action.   In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action.   In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

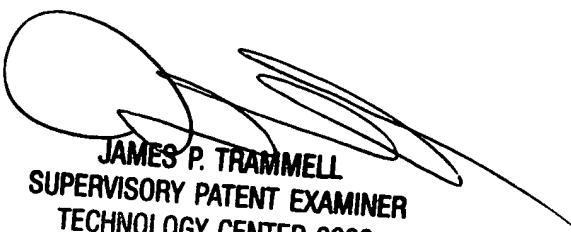### **Washington, D.C. 20231**
or faxed to:

(703) 305-7687   [Official communications; including

After Final communications labeled "Box AF"]

(703) 308-1396   [Informal/Draft   communications,   labeled

·"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

JAR

02 December 2002

JAMES P. TRAMMELL
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